

REMARKS

I. Claims

At this time, five (5) claims are pending in the application. Of the pending claims, three (3) claims are independent.

II. Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-4 under 35 U.S.C. §103(a) as being unpatentable over Mini et al. (U.S. Pat. No. 4,978,021) in view of Gahm US 3,285,459, Zanegood US 2,940,447, and Douglas US 1,040,652. However, since the Examiner has failed to make a *prima facie* case for rejection under section 103(a), Applicant respectfully requests that this rejection be withdrawn.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143. Because the cited references do not teach or suggest all of the claim limitations and because there is no suggestion or motivation to combine the references, the Examiner has failed to make a *prima facie* case for obviousness under 35 U.S.C. § 103(a).

The mere fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. MPEP § 2143.01. “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching

or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (Emphasis in original).

For the section 103 rejections discussed herein, the Examiner has combined and/or modified references based on impermissible hindsight reasoning without any teaching, suggestion, or motivation in the references or in the knowledge of one skilled in the art. It is respectfully submitted that the Examiner is unable to point to any information in the references themselves which motivates the stated combinations or modifications and relies entirely on information from the present application itself.

In addition, even when these references are combined and/or modified, the combined and/or modified references fail to teach or suggest all of the claim limitations. None of the cited references teaches, suggests, or motivates “providing a vented pocket attached to another of said plurality of telescoping components” of a collapsible cup nor do the references teach, suggest, or motivate “disposing a pill in said vented pocket”.

Furthermore, none of the cited references teaches, suggests, or motivates combining the cited references to provide a collapsible cup having a vented pocket or storing a pill in the vented pocket of a collapsible cup.

Although the Examiner only addresses claims 1-4 in the Office action, it is Applicant’s position that all claims are allowable over the cited art and so this omission is moot.

The Examiner in the Office action includes a discussion of the types of materials taught or suggested by the cited references for making the telescoping components, including paper or plastic. However, it is unclear to Applicant what the significance of this discussion is since there is nothing in the claims which limits the claimed invention to a particular type of material. Similarly, Applicant is uncertain of the relevance of the discussion of whether the telescoping components increase or decrease in size from top to bottom, since again there is nothing in the claims which limits the invention to one or the other configuration.

III. Conclusion

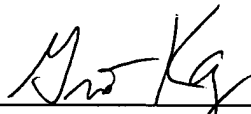
Applicant respectfully submits that all claims are allowable over the prior art of record, including the cited references.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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